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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/720,951

11/24/2003

Lawrence C. Don

DON1.DIV

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05/16/2005

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EXAMINER

SLACK, NAKO N

ART UNIT

PAPER NUMBER

3635

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/720,951

Applicant(s)

DON ET AL.

Examiner

Naoko Slack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 11-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Terminal Disclaimer***

Applicant's Terminal Disclaimer received December 22, 2004 to obviate the double patenting rejection over US Patent 6,651,393 has been entered.

### ***Restriction***

Restriction to one of the following inventions was required under 35 U.S.C. 121:

- I. Claims 1-10, drawn to a prefabricated building comprising a floor/ceiling assembly, classified in class 52, subclass 264.
- II. Claims 11-14, drawn to a prefabricated building comprising a removable roof assembly, classified in class 52, subclass 93.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, a prefabricated building comprising a floor/ceiling assembly can be constructed without a removable roof assembly. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Ryan A. Schneider on May 11, 2005 a provisional election was made without traverse to prosecute the invention of Group I,

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claims 1-10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-14 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Objections***

Claim 2 is objected to because of the following informalities: In claim 2, line 3, the word - - is - - should probably be inserted after "attenuation members". In claim 2, line 6, "top" should probably be - -bottom - -. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1,2, 4-10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US Patent 4,441,286 to Skvaril.

Claim 1:

Skvaril discloses a construction system for a structure, the structure being formed of manufactured units, an improvement to the construction system comprising: manufactured units that are approximately at least majority-finished at a site distant the building site of the structure, the approximately at least majority-finished manufactured units assembled together to form the structure at the building site (column 1, lines 44-52); and a floor/ceiling assembly locatable between vertically adjacent units (2, Figure 2), the floor/ceiling assembly incorporating a sound attenuation member (column 6, lines 18-20).

Claim 2:

Skvaril's floor/ceiling assembly comprises structural members with top and bottom flanges (3D and 3E, Figure 3) wherein the sound attenuation member in communication with the bottom flanges; a floor in communication with the top flanges (column 6, lines 20-26); and a ceiling in communication with either or both of the top flanges and the sound attenuation member (column 6, lines 20-26).

Claim 4:

Skvaril's interconnection system is a non-welding connection means (column 6, lines 55-63).

Claim 5:

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Skvaril discloses a construction system for a structure further comprising a stabilization assembly erected at the building site (column 3, lines 21-30), the stabilization assembly providing a stable construction assembly to which the units can be attached during construction of the structure.

Claim 6:

Skvaril discloses a construction system for a structure, the structure being formed of manufactured units, an improvement to the construction system comprising: manufactured units that are approximately at least majority-finished at a site distant the building site of the structure, the approximately at least majority-finished manufactured units assembled together to form the structure at the building site; and a load-bearing assembly for a unit (column 1, lines 57-62), the load-bearing assembly to transfer at least a majority of the loads of the structure, thus freeing the walls of the units from such load transfer, enabling the walls of the units to be approximately at least majority-finished distant from the building site of the structure.

Claim 7:

Skvaril's discloses connection subassemblies (column 6, lines 55-63) to connect the load-bearing members of two adjacent units.

Claim 8:

Skvaril's load-bearing members are at least approximately vertical members (column 1, lines 57-62) and the connection subassemblies (7A and 6C, Figure 3) connecting the at least approximately vertical members of two vertically adjacent units.

Claim 9:

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Skvaril's vertical members of the load-bearing assembly being of unitary size (2, Figure 2).

Claim 10:

further comprising a stabilization assembly (column 3, lines 22-30) erected at the building site, the stabilization assembly providing a stable construction assembly to which the units can be attached during construction of the structure.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,441,286 to Skvaril in view of US Patent 5,483,773 to Paisien.

Claim 3:

Skvaril teaches an interconnection system (column 6, lines 55-63) enabling the connection of units at the building site, which interconnection assembly does not significantly inhibit the finishing of the units at a site distant the building site of the structure.

While Skvaril does not show a floor/ceiling assembly comprising a balcony, balconies are well known in the art, as dictated by aesthetic design choice. For

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example, Parisien teaches a prefabricated balcony which open to the environment and easily fastened to the structure (column 1, lines 29-31). In view of Parisien, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form a balcony on the building, as Skvaril states that units may be easily added to the structure for horizontal expansion (column 2, lines 16-21).

#### ***Prior Art***

The following references are considered relevant prior art:

US Patent 4,854,094 to Clark;

US Patent 5,412,913 to Daniels et al.; and

US Patent 6,067,771 to Blankenship.

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naoko Slack whose current telephone number is 571-272-6848. The examiner can normally be reached on Mon-Fri (6:00 am-2:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naoko Slack  
Primary Examiner  
Art Unit 3635

NS  
May 11, 2005